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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,495	01/13/2005	Gerard O'Beirne	PA0248	2631

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EXAMINER	
BOESEN, CHRISTIAN C	

ART UNIT	PAPER NUMBER
1639	

NOTIFICATION DATE	DELIVERY MODE
06/11/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

melissa.leck@ge.com

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/521,495	**Applicant(s)** O'BEIRNE ET AL.	
	Examiner CHRISTIAN BOESEN	**Art Unit** 1639	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 May 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on *17 May 2010*. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: ___. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): ___.
6. ☐ Newly proposed or amended claim(s) ___would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: ___.
   Claim(s) objected to: ___.
   Claim(s) rejected: ___.
   Claim(s) withdrawn from consideration: ___.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: ___.

/Jeffrey S. Lundgren/
Primary Examiner, Art Unit 1639

Continuation of 11. does NOT place the application in condition for allowance because: Continuation of 11. does NOT place the application in condition for allowance because: The Applicant alleged that the rejections are improper largely for the reasons of record in the Reply filed on 01/12/2010. However the Examiner disagrees for the reasons in set forth in the Final Action mailed 10/01/2009. Accordingly, the rejections are maintained. Specifically, the Applicants argue:

1. "Applicants submit it is clear from the claims and the description that three elements are included in the claimed method: an indicator, a modulator, and an effector. The indicator includes a detectable label and means to render the detectable label to result in a characteristic localization. Such means may be an effector. However, Applicants assert that the claims are clear that the indicator, although may include an effector fused with a detectable label, is a separate entity from that of the effector being assayed in step (i) of claim 1. Thus, the indicator may even include a fusion of the same effector being assayed in step (i) of claim 1, with a detectable label, as claimed in claim 9." (Reply page 4 center). In response to Applicant's arguments, the Examiner respectfully notes that this argument is not clear given that the final office action of 11/17/2009 describes two separate entities ""GFP" (reads on the "indicator") and another protein (such as a protein kinase) (reads on the "effector")" (page 8 top).
2. "Thastrup teaches the use of only two components" (Reply page 5 top). In response to Applicant's arguments, the Examiner notes Applicants specifically argue the GFP fusion protein of the Thastrup reference such as the PKA-GFP fusion "is the equivalent of the indicator in the present invention". Neither the instant specification nor the claims provide any particular structures for the term "indicator" or "effector". In fact, the instant claims recite "fusion" proteins that comprise both the indicator (GFP) and the effector (see claim 9). The instant specification also discloses similar fusion proteins as including both the indicator and the effector (e.g. pp.19+). Thus, it is not clear how the fusion protein (with GFP + another protein) of the instant disclosure would be considered to have both the indicator and the effector, but the same type of fusion protein (with GFP + another protein) would not be considered to have both the indicator and the effector.
3. "The method of Thastrup provides means to determine whether a substance having biological activity is active against a chosen known cellular process, e.g. to determine if a drug candidate compound inhibits a cellular signalling pathway which is the focus of a therapeutic program. In this aspect the method of Thastrup conforms to standard drug screening methodology, i.e. providing an assay against which multiple compounds may be individually tested in parallel for activity." (Reply page 5 center). In response to Applicant's arguments, the Examiner respectfully disagrees. It is noted that the features upon which applicant relies (i.e., "drug screening methodology" that are not "standard", "function of one" the components is not "known", "networks of functional linkages", etc) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).